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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/690,667   | 10/17/2000  | Steven MacWilliams   | 00725.0360-US-01    | 3418             |
| 22865  | 7590        | 05/24/2006           | EXAMINER            |                  |
| ALTERA LAW GROUP, LLC<br>6500 CITY WEST PARKWAY<br>SUITE 100<br>MINNEAPOLIS, MN 55344-7704 |             |                      | HENDERSON, MARK T   |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3722                |                  |

DATE MAILED: 05/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/690,667

Applicant(s)

MACWILLIAMS, STEVEN

Examiner

Mark T. Henderson

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 and 34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 and 34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Attachment I, II, III.

## **DETAILED OFFICE ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing or responses to Office Actions directly into the Group at (571) 273-8300. This practice may be used for filing papers, which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Response to Amendment***

1. In view of the Pre-Brief Conference Request filed on December 19, 2005,  
PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee

can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear of what applicant means by the term “lighter”. The term “lighter” could be related to weight or color.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 4, 5, 8, 11, 15, 16, 26-29, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Swallow (5,820,958).

Swallow discloses in Fig. 1, 4 and Attachment I, a label comprising a substantially planar first layer (12) having a first surface; a second layer (11) including a non-adhesive label material having an adhesive (16 and 18), which is permanently attached to the second surface (12b) of the first layer (12); the second layer (11) having an adhesive (13) on an outer surface (11b) of the non-adhesive material or second layer (11); the non-adhesive label material (11) having a first section (A) and a second section (B) and a gap (C) of discontinuity defining a section in the first layer; wherein the second layer (11) covering all of the second surface (12B) except for the line section (C); wherein the second layer has a thickness.

In regards to **Claims 1 and 26**, wherein the section is foldable, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the second layer section can be foldable to be placed on a stock member.

In regards to **Claims 1, 8, 15, and 26**, wherein a folding pressure is applied such that the label folds along a section such that the first section of the second layer is attached to a first side of a stock member and the second section is attachable to a second side of a stock member, and wherein neither the first or second of the second layer bends; wherein a gap indicates a label fold

line for matching with the edge of a stock member; and a fold-line section, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the label of Swallow can be: folded onto a stock member when a folding pressure has been applied; the gap can be used to indicate any type of line or section.

In regards to **Claim 11**, the method of a gap being discernible does not structurally limit the claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process (see MPEP 2113). Therefore, it would be obvious to make the gap discernible in any manner. It is advised that the limitation should be written “wherein the gap is discernible”.

4. Claims 30 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Cunningham (2,893,144).

Cunningham discloses in Fig. 1, 2, 5, 8 and Attachment II, a method of applying a label (10) to an edge of a stock member (see Fig. 1) comprising: aligning the label (10) such that a visually discernible gap (G) is aligned with an edge of a stock member (see Fig. 5 and 8); applying a first portion (11 and 13) to a first side of a stock member folding along the gap defined by a weakened line running along the surface of the label and applying the second portion to a second side of the stock member (Col. 3, lines 25-37); and wherein the label has a first layer (11) and a second layer (13 and 14),

wherein the second layer comprises the gap which is discernible through the first layer (first layer is transparent).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swallow.

Swallow discloses a label comprising all the elements as disclosed in Claim 1, and as set forth above. However, Swallow does not disclose; wherein the fold-line section is offset from a centerline of the first layer; and wherein the second layer has at least two gaps and foldable upon a three dimensional tab member.

In regards to **Claim 6**, it would have been obvious to place the second layer section at any desired location, since it has been held that rearranging parts of an invention involves only routine skill in the art. Therefore, it would have been obvious to place the second layer section at any desired location since applicant has not disclosed the criticality of having the section at a particular location, and would function equally as well at any location. Furthermore, wherein the section is foldable, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably

distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the second layer section can be foldable to be placed on a stock member.

In regards to **Claim 7**, wherein the second layer has at least two gaps, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct any number of gaps in the second layer, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. Therefore, it would have been obvious to place any desirable number of gaps in the second layer, since applicant has not disclosed the criticality of having more than one gap, and invention would function equally as well with at least one gap.

6. Claims 1, 9-17, 19-23, 25 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abrams (5,656,362).

Abrams discloses in Fig. 4, 5 and Attachment III, a label comprising a substantially planar first layer (50), which is transparent or translucent having a first surface (50a) and second surface (50b); a second layer (52) including non-adhesive label material (printed matter) which is permanently attached to the second surface (50b), wherein the second layer having an adhesive (56) on an outer surface (52b) of the non adhesive label material; wherein the non-adhesive label material of the second layer having a first section (52a) and a second section (52c), and a gap (52G) defining a complete separate section there between; wherein it is inherent that the indicia



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is capable of covering all of the second surface depending on the size of the printed matter (which range from

alphanumeric symbols to decorations as stated in Col. 5, lines 1-5) placed on the first layer surface; and wherein the second layer can comprise any type of color light or dark (Col. 4, lines 55-67); and wherein the gap is discernible through the first layer which is transparent or translucent.

However, Abrams does not disclose: wherein the second layer comprises security label material; wherein the gap indicates a fold line for matching with the edge of a stock member; wherein the first layer folds along a fold-line section when a force is applied; wherein the gap is offset from a first layer centerline.

In regards to **Claim 14 and 23**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct second layer in any desirable material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. Therefore, it would have been obvious to construct the second layer with any desired material, since applicant has not disclosed the criticality of using a particular material, and invention would function equally as well with any desired material.

In regards to **Claim 15-17, 22 and 34**, wherein the gap indicates a fold line, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from

the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the gap of Abrams can be used to indicate for any desirable purpose.

In regards to **Claim 20**, it would have been obvious to place the second layer section at any desired location, since it has been held that rearranging parts of an invention involves only routine skill in the art. Therefore, it would have been obvious to place the second layer section at any desired location since applicant has not disclosed the criticality of having the section at a particular location, and would function equally as well at any location.

### *Response to Arguments*

Applicant's arguments with respect to claims 1-31 and 34 have been considered but are moot in view of the new ground(s) of rejection.

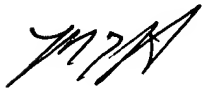
Swallow and Abrams are now used to disclose a label comprising a first and second layer defining a gap in the second layer. The Swallow reference is used to disclose a double-sided adhesive label, which discloses all the limitations of applicant's invention. The Abrams reference is used to disclose a label having a first layer and a print second layer located underneath the first layer, but between a third adhesive layer. However, Swallow and Abrams do not disclose the intended use of folding the label along a gap section formed by the second layer around a stock member. The examiner submits that a recitation of the intended use of the

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claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

### Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571) 272-4477, and informal fax number is (571) 273-4477. The examiner can be reached on Monday-Friday from 9:00AM to 3:45PM. If attempts to reach the examiner by telephone are unsuccessful, the Examiner Supervisor, Monica Carter, can be reached at (571) 272-4475. The formal fax number for TC 3700 is (571) 273-8300.



MTH

May 21, 2006



MONICA CARTER  
SUPERVISORY PATENT EXAMINER

FIG. 3

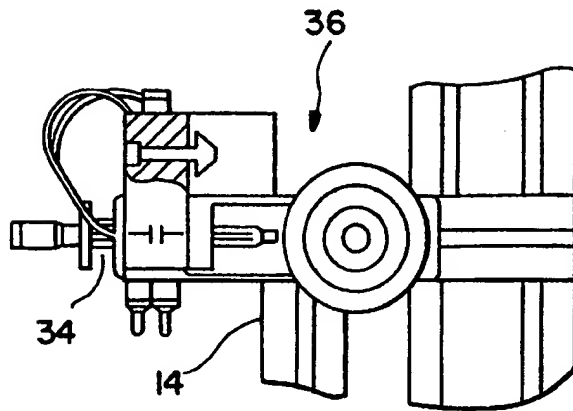


FIG. 4

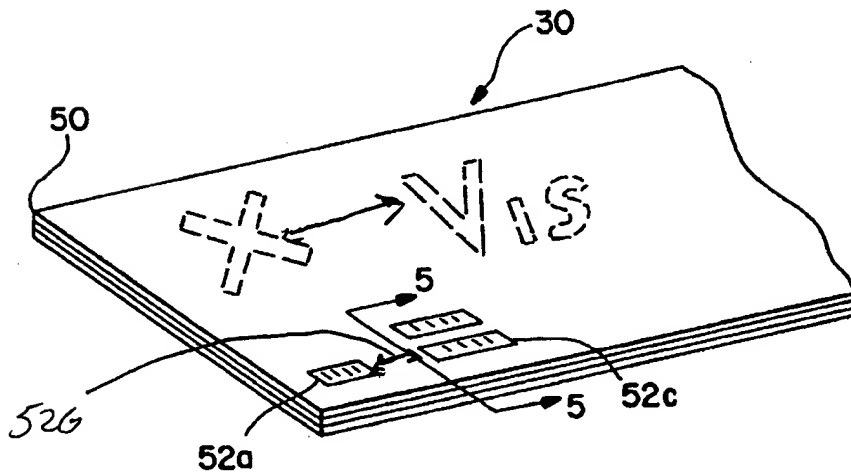
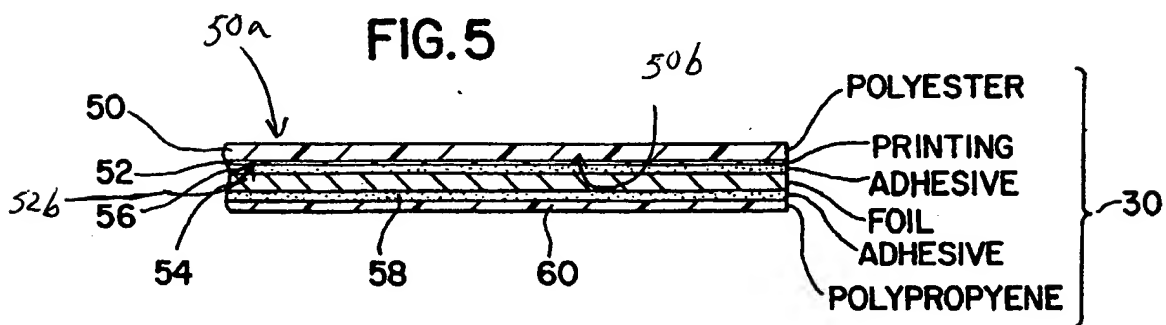


FIG. 5



July 7, 1959

W. F. CUNNINGHAM

2,893,144

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Filed Nov. 16, 1953

Fig. 1

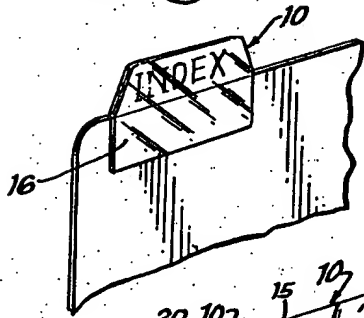


Fig. 6

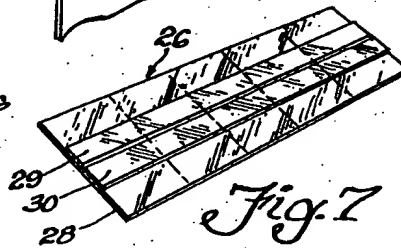
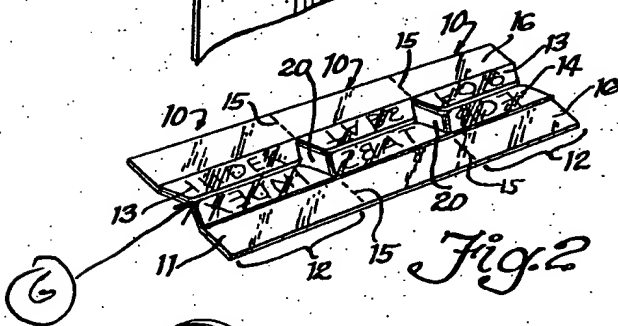
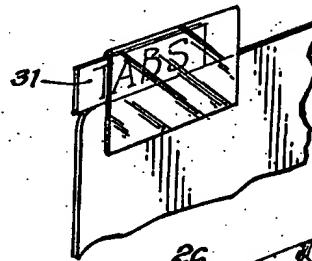


Fig. 7

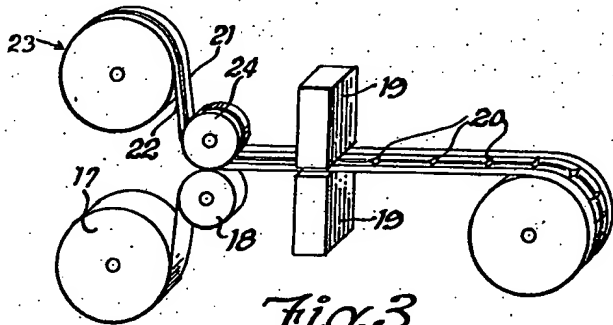


Fig. 3

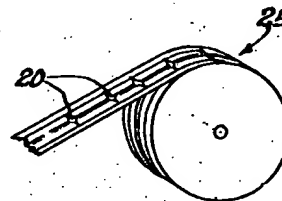


Fig. 4

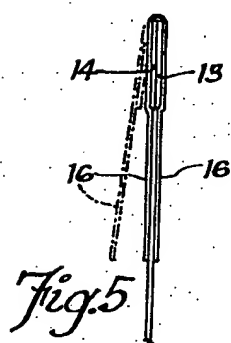


Fig. 5

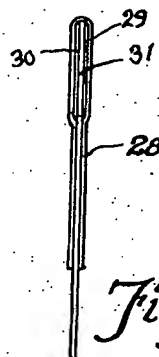


Fig. 8

INVENTOR  
Walter F. Cunningham  
BY Sheridan Davis  
and Cargill  
Att'ys

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